



UNITED STATES PATENT AND TRADEMARK OFFICE

T

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,652	09/25/2006	Hisayoshi Ito	2224-0260PUS1	5762

2292 7590 08/27/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

MESH, GENNADIY

ART UNIT	PAPER NUMBER
----------	--------------

1711

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

08/27/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/580,652	Applicant(s) ITO, HISAYOSHI	
	Examiner Gennadiy Mesh	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's Amendment filed on August 3, 2007 is acknowledged.

Rejection is maintained as it was set forth in previous Office action mailed on April 30, 2007.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-10 in the reply filed on August 3, 2007 is acknowledged. The traversal is on the ground(s) that Special Technical Feature can be added during prosecution of the Application. This is not found persuasive because in this case new special technical feature will be rejected as New Matter.

Regarding Applicant's argument that search for both Groups I and II can be made without serious burden: this argument is irrelevant to the basis of Restriction requirement under PCT Rule 13.1 for Groups I and II as they lack the same or corresponding Special Technical Features.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1 - 7 and 9 - 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

Art Unit: 1711

claimed invention: amended Claim 1 contains negative limitation as “ component (A) is not formed by seed polymerization using an addition polymerization polymer “ – specification and particularly paragraph [0065] as it pointed out by Applicant, do not provide support for this negative limitation.

Claim Rejections - 35 USC § 102

2. Claims 1- 7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigemori et al.(US 2003/0049559).

Regarding applicant's Claims 1-4,6 and 9 Shigemori discloses method of producing toner particles, wherein particles comprises one or more of thermoplastic polymers (see [0019]) as a styrenic resins, including copolymer with maleic acid polyester or/and polyamide or their mixture, and represent hydrophilic polymers, with functional groups (carboxyl for example) and other solid organic materials as low molecular weight waxes(see [0031]), represent hydrophobic polymers.

Regarding affinity to water-soluble component B: due to solubility in water, component B is hydrophilic, thus hydrophobic polymers of the composition will have different affinity to component B compare with hydrophilic polymers.

Regarding Claim 5 Shigemori discloses that particle has core – shell structure, wherein shell thickness varies from 0.001 micron to 1 micron (see [0035]).

Regarding Claim 7 Shigemori discloses that amount of waxes(see [0033]) could in range from 0.5 parts to 50 parts based on 100 parts of thermoplastic polymers – this reads on limitation of Claim 7.

Regarding Claim 10 Shigemori discloses that particles are substantially spherical (see [0096]) and average particle size in a range from 2 microns to about 10 microns (see [0096]).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/515,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because, claims 1-28 of copending Application 10/515,420 drawn to dispersed composition, comprising same basic compositional components and claim 28 drawn to process of producing particles with characteristics identical to those claimed by Applicant in concerning

Art Unit: 1711

Application No. 10/580,652. Thus, claimed subject matter of concerning Application and Application No.10/515,420 significantly overlapping in scope and represent obvious modifications of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 18 of copending Application No. 10/580,605 in view of Shigemori et al.(US 2003/0049559).

Although the conflicting claims are not identical, they are not patentably distinct from each other because, claims 1- 18 of copending Application 10/580,605 drawn to dispersed composition, comprising solid organic component A . As it was discussed above , Shigemori disclosed same basic component A in colored composition for toner.

Therefor, it would have been obvious to incorporate component A disclosed by Shigemori in order to obtain colored composition useful for toner to the language of Claims 1-24 of the concerning Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed August 3,2007 have been fully considered but they are not persuasive.

Regarding Applicant's arguments related to Claims 1- 7 and 9-10 rejected under 35 U.S.C. 102(b) as being anticipated by Shigemori et al.(US 2003/0049559): arguments based on statement that Shigemori disclose only emulsion based polymer for polymer composition. This is not found persuasive, because Shigemori does disclose polycondensation polymers as polyamide or polyester as part of the composition –see [0020].

Regarding arguments related to Double Patenting rejection over claims 1-28 of copending Application No. 10/515,420 : claimed subject matter as a Composition of all both Applications comprising **same basic components** : see Claim 4 of the Application 10/515,420 and Claim 9 of the instant Application 10/58,0652.

Regarding arguments related to Double Patenting rejection over claims 1- 18 of the copending Application No. 10/580,605 in view of Shigemori et al.(US 2003/0049559) : arguments are moot in view of new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1711

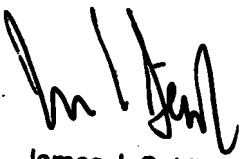
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gennadiy Mesh whose telephone number is (571) 272 2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GM


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

Gennadiy Mesh
Examiner
Art Unit 1711